

#2

P/2167-221

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

Thomas Mackay, et al.

Serial No. 09/631,810

Filed: August 3, 2000

For: WORKFLOW MANAGEMENT SYSTEM AND METHOD

Date: October 26, 2000

**RECEIVED**

**OCT 27 2000**

**OFFICE OF PETITIONS**

Hon. Commissioner of Patents and Trademarks

Washington, D.C. 20231

**PETITION TO COMMISSIONER UNDER 37 C.F.R. 1.53(e)(2)**

Sir:

Responsive to the Notice of Omitted Items mailed October 2, 2000 (attached hereto as Exhibit A), Applicants, by OSTROLENK FABER GERB & SOFFEN (OFGS), their undersigned attorneys, hereby respectfully petition the Commissioner for a ruling that attached pages 2, 3 and 25 (Exhibit B) be deemed part of the specification as of the original filing date of August 3, 2000.

Our check in the amount of \$130.00 pursuant to 37 C.F.R. 1.17(i) is attached hereto. If the actual fee is greater than the payment submitted or is inadvertently not enclosed, or if any additional fee during the prosecution of this case is not paid, the Patent and Trademark Office is authorized to charge the underpayment to Deposit Account No. 15-0700.

**BACKGROUND FACTS RELATING TO THE PETITION**

The above-identified patent application was filed by Express Mail on August 3, 2000. As indicated by both OFGS' business records and the Post Card stamped and returned by the U.S. Patent and Trademark Office (PTO), the application as deposited with the U.S. Postal Service consisted of the following items:

- (a) 99 pages of Specification, Abstract and Claims;
- (b) 158 claims;
- (c) 49 sheets of drawing;
- (d) Declaration and Power of Attorney;
- (e) Assignment and Conveyance Cover Sheet;

Adjustment date: 04/10/2001 LGIBBS  
10/30/2000 LGIBBS 00000002 09631810  
01 FC:122 -130.00 OP  
Ref'n. Ref: 04/10/2001 LGIBBS 001423010  
Ref: 150700 Name/Number: 09631810  
FC: 704 \$130.00 CR  
10/30/2000 LGIBBS 00000002 09631810  
01 FC:122 130.00 OP

- (f) Check for filing fee and recordation of Assignment; and
- (g) Return-addressed Post Card [listing items (a) - (f) above].

The Notice of Omitted Items (Exhibit A) mailed by the PTO states that pages 2, 3 and 25 were missing from the specification as filed. A filing date of August 3, 2000 was accorded the application as purportedly filed, i.e., without pages 2, 3 and 25.

#### EVIDENCE SUPPORTING THE PETITION

##### *Declaration Maria Lapitan (Attached Exhibit C):*

Ms. Lapitan is a secretary employed by applicants' undersigned attorneys, and assigned to work for Lawrence A Hoffman, an attorney at the firm. Mr. Hoffman was responsible for the above-identified patent application.

At Mr. Hoffman's request, Ms. Lapitan prepared a Declaration and Power of Attorney and an Assignment, and forwarded these documents to the client for execution by the inventors. When the signed documents were returned by the client, , Ms. Lapitan prepared the application for filing.

According to the firm's standard procedures, Ms. Lapitan obtained photocopies of the specification and drawings, and a check in the amount of \$3,292.00 covering the filing fee and the assignment recording fee. She then prepared a Transmittal Letter (a copy of which is attached to her Declaration as Exhibit 1, an Assignment Cover Sheet, a return-addressed postcard and an express mail envelope addressed to the Honorable Commissioner of Patents and Trademarks.

After obtaining copies of the specification and drawings, she checked to be sure that no pages were missing. The copies of the specification, including abstract and claims, all consisted of 99 numbered pages.

Still following the firm's standard procedures, on August 3, 2000, Ms. Lapitan had Dorothy Jenkins, a receptionist at OFGS, sign an Express Mail Certificate on the Transmittal Letter and then gave the Transmittal Letter, together with the Assignment Recordation Cover Sheet, to Mr. Hoffman for signature. After Mr. Hoffman signed these documents, she made photocopies, and then assembled complete PTO, file and client copies of the application.

As listed in the Transmittal Letter (Exhibit 1 to Ms. Lapitan's Declaration), each copy of the application as assembled by her included:

- a) The specification, abstract and claims of the above application consisting of 99 numbered pages;
- b) 49 sheets of informal drawings, Figs. 1-19B;
- c) The Transmittal Letter;
- d) The Declaration and Power of Attorney;
- e) The Assignment and Cover Sheet;
- f) The check for \$3,292.00; and
- g) The return-addressed postcard receipt listing each of items (a)-(f) above.

The signed originals of the Declaration and Power of Attorney, the Assignment and Cover Sheet and the Transmittal Letter, as well as the check and the post card all were included in the PTO copy of the application .

After the copies were assembled, Ms. Lapitan gave the PTO copy to Mr. Hoffman for a final check. When he returned the copy, she placed it in the Express Mail envelope she had prepared, sealed the envelope and gave it to Ms. Jenkins to be deposited with the U.S. Postal Service. She then prepared and signed a Certification, a copy of which is attached to her Declaration as Exhibit 2, stating that all the items listed in the Transmittal Letter were included in the copy of the application being mailed to the PTO.

At no time did she remove any items from the assembled PTO copy of the application, and in particular, did not remove pages 2, 3 and 25 of the specification.

*Declaration of Lawrence A Hoffman (Attached Exhibit D):*

Mr. Hoffman is the attorney at OFGS who was responsible for the subject patent application. After the application had been reviewed in final form by the inventors, Mr. Hoffman instructed his secretary to prepare a Declaration and Power of Attorney and an Assignment, and to send these documents to the client for execution by the inventors. When the executed documents were returned, he directed Ms. Lapitan to prepare the application for filing.

On August 3, 2000, Ms. Lapitan delivered copies of the standard OFGS Transmittal Letter and Assignment Cover Sheet to Mr. Hoffman for signature, which he signed and returned to

her. Ms. Lapitan assembled a complete copy of the application for filing in the PTO, including the signed originals of the various documents, and gave it to Mr. Hoffman for final review. Mr. Hoffman did not remove any items from the assembled PTO copy of the application, and in particular, did not remove pages 2, 3 and 25 of the specification.

Upon receiving the Notice of Missing Parts, he checked the central repository where the original postal cards are kept after return by the PTO, and located the card for the subject application. A copy of the card is attached to his Declaration as Exhibit 1. He also located the U.S. Postal Service Express Mail Receipt for the subject application. A copy of the Express Mail Receipt is attached to his Declaration as Exhibit 2.

*Declaration of Dorothy Jenkins (Attached Exhibit E):*

Ms. Jenkins is a receptionist at OFGS. Among her duties is to arrange for collection of outgoing Express Mail packages by the U.S. Postal Service. On August 3, at the request of Ms. Lapitan, Ms. Jenkins signed the Express Mail Certificate appended to the Transmittal Letter and returned the document to Ms. Lapitan. She thereafter received a sealed package from Ms. Lapitan, and placed the package for collection by the U.S. Postal Service without opening it. Ms. Jenkins did not remove any documents from the sealed envelope given to her by Ms. Lapitan.

ARGUMENTS IN SUPPORT OF PETITION:

It is respectfully submitted that the weight of the evidence overwhelmingly demonstrates that pages 2, 3 and 25 were part of the specification when the application was delivered to the U.S. Postal Service and when received by the PTO mail room. The Transmittal Letter, the post card and Ms. Lapitan's Certification, which are business records of OFGS kept in the ordinary course of its business, all state that the specification, including the claims and abstract, comprised 99 pages at the time of mailing.

Consistent with the business records of OFGS, the post card receipt indicates that when the envelope was opened by the PTO mail room, *all 99* pages of the specification were present. Had pages 2, 3 and 25 been missing when the Express Mail envelope was opened by the PTO mail room, the specification would have consisted of only 96 pages.

It is clear from the foregoing that the missing three pages were part of the application as filed, and were apparently misplaced by the PTO before the application was reviewed by the

Initial Patent Examining Division which issued the Notice of Omitted Items. Accordingly, the August 3, 2000 filing date should apply to all 99 pages of the specification.

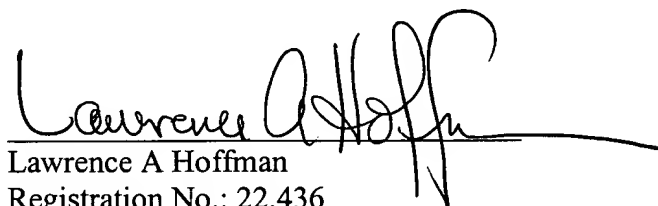
In view of the foregoing, Applicants respectfully requests that this petition be granted and that the application be deemed to include pages 2, 3 and 25 as of the original filing date of August 3, 2000.

Respectfully submitted,

**RECEIVED**

**OCT 27 2000**

**OFFICE OF PETITIONS**



Lawrence A Hoffman

Registration No.: 22,436

OSTROLENK, FABER, GERB & SOFFEN

1180 Avenue of the Americas

New York, New York 10036-8403

Telephone: (212)382-0700